

Attorney Docket No. IPCP:107US
U.S. Patent Application No. 09/931,492
Reply to Office Action of June 8, 2004
Date: August 27, 2004

Remarks/Arguments

The Rejection of Claims 1-10, 14-16, 19-32, 36-38, and 41-44 Under 35 U.S.C. §103

The Examiner rejected Claims 1-10, 14-16, 19-32, 36-38, and 41-44 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,339,767 (Rivette et al.) in view of U.S. Patent No. 6,154,725 (Donner). Applicants respectfully traverse this rejection as follows.

Regarding amended Claim 1, Applicants disagree with the Examiner's statement that Rivette discloses the Claim 1 elements of a searchable document database and a publication Web site in communication with a document database. Rivette is concerned with processing data. As stated in the first sentence of the Abstract: "A system, method, and computer program product for *processing* (emphasis added) data are described herein." In the Summary of the Invention, Rivette further describes the invention as maintaining databases and groups, performing processing functions such as patent and document mapping, and having the ability to display hyperbolic trees. Rivette is silent regarding publication. Applicants performed a word search of Rivette and discovered that the word "publication" is not used in Rivette.

As well as failing to teach publication, Rivette also contains no suggestion regarding publication or the amended Claim 1 limitation that publishing is for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product. Rivette presents a synopsis of his invention in col. 10, lines 59-67:

The present invention is directed to a system, components of the system, a method, components of the method, and a computer program product for patent-centric and group-oriented data processing. Such processing includes, but is not limited to, reporting, analyzing, and planning.

The present invention is intended to aid a corporate entity in developing business-related strategies, plans, and actions. Accordingly, the present invention is also referred to herein as a business decision system and method.

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The present invention is meant to be a very public and accessible process. That is, the goal of the present invention is to make a product document “sufficiently accessible to one skilled in the relevant art who exercise reasonable diligence” within the meaning of 35 U.S.C. §102(b). Hence, the present invention places publications in the public domain for purposes of establishing bars to patentability. On the other hand, Rivette is disclosing a system and method for internal use by a corporate entity as part of its decision-making process. This is the antithesis of a public and accessible process. Corporate viability and even survival require that business strategies and plans not be made accessible to competitors. Therefore, business entities go to great lengths to ensure the confidentiality and secrecy of meetings, documents, and data involved in decision-making/business plans. Thus, Rivette does not teach a Web publication site or include any motivation or suggestion regarding a Web publication site.

The Examiner states that Donner teaches the amended Claim 1 element of: “electronically receiving said product document transmitted by a client’s computer...” Applicants respectfully disagree. In general, Donner teaches retrieving data as in col. 5, lines 18-20: “Next, the data would be transmitted to a database access device 16 which would collect *various data* (emphasis added) from different on-line intellectual property databases 18.” In col. 6, lines 53-56 Donner states that a patent can be obtained using DIALOG. However, a patent is not analogous to a product document produced by a client. Further, Donner teaches receiving data or patents from a public database, for example, LEXIS, rather than a client’s computer.

The Examiner also states that Donner discloses the amended Claim 1 element of publishing a product document by adding the product document to a document database. Donner does not teach any type of publication, specifically publication for the purpose of disclosing information about a product to establish a bar to patentability of inventions practiced in said product. The only documents that Donner teaches accepting are patents. Publishing a patent cannot establish a bar to patentability. The statutory bar presented by a patent is related to the priority date of the patent and is completely independent of any publication of the patent on a Web site. Assuming *arguendo* that documents other than patents were obtained by Donner, these documents would be obtained from a publicly accessible database. That is, a bar to

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patentability would already have been established by the presence of the document on a public database.

Further, Donner contains no motivation to publish a product document for purposes of establishing a bar date. Donner is describing an analysis tool, not a means of putting a document in the public domain, col. 4, line 66 to col. 5, line 9:

The intellectual property audit system according to the present invention may be used as an integrity check for acquisitions having assets involving a substantial intellectual property portfolio. The system could be used to compare the intellectual property portfolio to be acquired with other intellectual property portfolios having known market values to obtain an indicator of the intellectual property portfolio's worth. Depending on the quality of empirical data, the intellectual property audit system of the present invention could provide a qualitative and/or quantitative analysis of an intellectual property portfolio which is to be acquired.

The Examiner has cited decreasing latency in document processing as the general motivation for combining Donner with Rivette. When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references and the teachings of the references can be combined only if there is some suggestion or incentive to do so. However, Applicants can find no suggestion in Rivette that latency is a problem and, therefore, fail to see how latency can be a motivation to combine Donner with Rivette. Further, latency appears to be irrelevant with respect to the divergent problems addressed by Rivette, Donner, and the present invention. For example, decreasing latency will not improve the quality of the patent-centric and group-oriented data processing of Rivette or the quality of the analysis performed by Donner.

In summary, the Examiner has not provided a motivation to combine references. Likewise, the fact that a modification would be within the ordinary skill of the art is not proof of motivation *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Applicants respectfully submit that the cited prior art is only modified in retrospect, in light of the present invention. That is, the obviousness rejection is based upon the Applicants' own invention characterization, not the modification of Rivette and Donner

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For the reasons set forth above, Applicants respectfully submit that, with respect to Claim 1, Rivette and Donner fail to satisfy the requirements for establishing a *prima facie* case of obviousness in accordance with MPEP § 2143. Therefore, Claim 1 is patentable over Rivette in view of Donner and Applicants respectfully request that the rejection be withdrawn. Claims 2-10, 14-16, and 19-22 depend from Claim 1, which is patentable in light of the cited references. Thus, Claims 2-10, 14-16, and 19-22 also are patentable in light of the cited references.

The Examiner has stated that Claim 23 is parallel with Claim 1 and rejected for the same reason. Therefore, Applicants respectfully submit with respect to Claim 23, Rivette and Donner fail to satisfy the requirements for establishing a *prima facie* case of obviousness in accordance with MPEP § 2143. Therefore, Claim 23 is patentable over Rivette in view of Donner and Applicants respectfully request that the rejection be withdrawn. Claims 24-32, 36-38, and 41-44 depend from Claim 23, which is patentable in light of the cited references. Thus, Claims 24-32, 36-38, and 41-44 also are patentable in light of the cited references.

The Objection of Claims 11-13, 17, 18, 33-35, 39, and 40 as Being Dependent Upon a Rejected Base Claim

Claims 11-13, 17, 18, 33-35, 39, and 40 were objected to as being dependent upon a rejected base claim, but the Examiner indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended Claims 1 and 23 to overcome the rejections cited in the Office Action. Therefore, Applicants respectfully submit that Claims 11-13, 17, and 18, dependent from Claim 1, no longer depend upon a rejected base claim; and, Claims 33-35, 39, and 40, dependent from Claim 23, no longer depend upon a rejected base claim. Applicants respectfully submit that these claims are now in condition for allowance, which action is courteously requested.

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Conclusion

Applicants respectfully submit that all pending claims are now in condition for allowance, which action is courteously requested.

Respectfully submitted,



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Dated: August 27, 2004